

## **REMARKS**

### **I. Status of the Claims**

Claims 1-41 and 44-56 are pending. By this amendment, claims 1 and 54-56 have been amended, and claims 42-43 have been cancelled without prejudice or disclaimer. Claims 1 and 54-56 have been amended to more distinctly claim that which Applicants regard as their invention. Support for these amendments can be found throughout the specification and claims as originally filed, for example, at paragraph [047] of the specification and original claims 42 and 43. Accordingly, no new matter is added herein.

### **II. Rejection under 35 U.S.C. § 103(a)**

In the Advisory Action, the Examiner maintains the rejection of claims 1-28, 36-43, and 45-56 under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,342,527 B1 to O'Lenick et al. ("O'Lenick") in view of U.S. Patent No. 6,491,927 B1 to Arnaud et al. ("Arnaud") for the reasons set forth in the previous Office Action dated November 1, 2007. See Advisory Action at 2.

Applicants respectfully submit that the rejection of record fails to meet the requirements necessary to establish a *prima facie* case of obviousness. The Federal Circuit recently stressed that the teaching, suggestion, or motivation ("TSM") test retains an important role in obviousness analyses. *Takeda Chem. Indus., Ltd. v. AlphaPharm Pty., Ltd.*, 83 U.S.P.Q.2d 1169, 1174 (Fed. Cir. 2007). The Court states that "[a]s long as the [TSM] test is not applied as a 'rigid and mandatory' formula, that test can provide 'helpful insight' to an obviousness inquiry. *Id.* (quoting *KSR Int'l Co. v. Teleflex, Inc.*,

127 S. Ct. 1727, 1731 (2007)). Moreover, the Federal Circuit stated that the Supreme Court in *KSR* “acknowledged the importance of identifying ‘a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in a way the claimed new invention does’ in an obviousness determination.” *Id.*

Furthermore, the Federal Circuit subsequently held that proper support for a § 103 rejection in the chemical arts requires the prior art to supply a reason or motivation to make the claimed compositions. *Aventis Pharma. Deutschland GmbH v. Lupin Ltd.*, 84 U.S.P.Q.2d 1197, 1204 (Fed. Cir. 2007) (emphasis added) (citing *Takeda*, 83 U.S.P.Q.2d at 1174).

With respect to the rejection over O’Lenick in view of Arnaud, Applicants reassert that the Examiner has provided no basis in the art as to why one skilled in the art would have been motivated to combine the specific elements identified in the prior art at issue to render the present invention obvious and, therefore, has failed to set forth a *prima facie* case of obviousness. Rather, the Examiner makes the conclusory assertion at page 6 of the Office Action dated November 1, 2007, that “[o]ne of ordinary skill in the art would be motivated to combine the teachings of O’Lenick et al with the teachings if Arnaud et al. due to the overlapping subject matter contained in each, most notably, cosmetic compositions containing polyesters resultant from esterification that can be lipstick as a finished product ....” *Id.* Applicants disagree.

O’Lenick teaches that “[t]he critical combination of branching and the polymeric composition unique to castor oil ... coupled with the proper selection of the fatty acid and diacid chosen to make the polyester results in a product that has unique gloss when applied to the skin.” See O’Lenick at Col. 1, ll. 37-39 and ll. 53-56. Thus,

O'Lenick attributes the gloss of the polyester obtained to the use of castor oil and in no way suggests or teaches that the addition of a high molecular weight oil would improve the glossiness of the polyester disclosed therein. Rather, O'Lenick's limited teachings are wholly silent as to any effect high molecular weight oils, as in the present invention, would have on specific polyesters.

The Examiner contends in the Advisory Action that "Applicant again advances no specific reasons elucidating how the teachings of O'Lenick fail to teach the claimed polyester." *Id.* at 2. The Examiner's assertion is misguided. Applicants have repeatedly argued that O'Lenick fails to teach or suggest the claimed polyester in combination with a high molecular weight oil having a molar mass from 650-10,000. See Response After Final dated February 29, 2008. Moreover, the Examiner has directly conceded this point in the Office Action dated February 14, 2007, and in the Final Office Action dated November 1, 2007.

The Examiner's reliance on Arnaud for the requisite high molecular weight oil component does not remedy the deficiencies of O'Lenick for at least the reasons set forth in the Response After Final dated February 29, 2008, and the Reply to Office Action dated May 30, 2007, which are incorporated herein by reference. In particular, Arnaud teaches "that specific esters, composed of saturated and branched C<sub>24</sub>-C<sub>28</sub> fatty alcohols or fatty acids ... possessed very good sensory properties ...." See Arnaud at Col. 1, ll. 42-46. Thus, Arnaud teaches that it is the particular esters, which do not overlap the esters of O'Lenick, that contribute the advantageous properties described therein. Only at col. 4, l. 40-col. 5, l. 30, does Arnaud even contemplate that the fatty phase (comprising the ester) may optionally comprise "one or more fatty substances

and in particular waxes, gums and oils” and then provides a listing of various waxes and oils.

The Examiner's reliance on the limited teachings of Arnaud cannot amount to a motivation for combination with O'Lenick. Instead, this rationale is akin to an obvious to try argument. As the M.P.E.P. explains, rejecting claims as “obvious to try” requires “(1) a finding that at the time of the invention, there had been a recognized problem or need in the art, which may include a design need or market pressure to solve a problem; (2) a finding that there had been a finite number of identified, predictable potential solutions to the recognized need or problem; (3) a finding that one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success; and (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.” M.P.E.P. § 2143(E).

Here, the Examiner fails to make a finding that there had been a finite number of identified predictable potential solutions to the recognized need or problem. Instead, the Examiner relies on a passage in Arnaud directed to optional ingredients for Arnaud's composition with no connection to the problem discussed in the present application and argues that it would lead a person of ordinary skill in the art to in the invention of the present application. Certainly nothing would lead one of skill in the art to select the particular oils of presently amended claim 1 from the listing of waxes, gums, and oils in Arnaud. The patchwork argument presented by the Examiner is only based on improper hindsight and not on any source of motivation from either reference or the art generally to make the proposed combination.

Further, in response to the Examiner's contention in the Advisory Action that "Arnaud et al teaches that CERTAIN high molecular mass esters are not desirable does not address the esters that would otherwise not have such undesirable properties and, therefore would have commended themselves to one of ordinary skill ... to be combined with the oil and compositions elements as taught by O'Lenick," Applicants respectfully submit that the Examiner is again relying on improper hindsight and not viewing the claimed subject matter as a whole relative to the prior art. In determining obviousness, § 103 expressly requires considering the claimed invention "as a whole." Moreover, "[a] reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect. On the issue of obviousness, the combined teachings of the prior art as a whole must be considered." See *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d at 907.

Applicants respectfully submit that the Examiner cannot simply ignore certain teachings in Arnaud in order to support an obviousness rejection. Arnaud expressly teaches away from certain high molecular mass liquid esters, including the oils of presently amended claim 1, pentaerythrityl tetra(isostearate) and triisoarachidyl citrate. See e.g., col. 1, ll. 30-35. Moreover, Arnaud discloses in its comparative examples at col. 7, ll. 15-30 and col. 8, ll. 45-55, that comparative compositions, comprising particular claimed high molecular weight oils combined with the claimed ester of Arnaud actually worsen sensory properties as compared with Arnaud's inventive compositions. This teaching away in Arnaud cannot be ignored and must be considered as part of the patent as a whole.

Thus, Applicants maintain the traversal of the rejection over O'Lenick in view of Arnaud for at least the reasons that there would be no motivation in O'Lenick to add the requisite high molecular weight oil from Arnaud to its compositions, let alone an expectation of success from such a combination in view of Arnaud's teaching away from claimed high molecular weight oils. Applicants respectfully request withdrawal of the rejection.

**III. Conclusions**

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this Preliminary Amendment, please charge the fee to Deposit Account No. 06-0916.

Respectfully submitted,

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